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09/757,179	01/08/2001	Dennis Boyle	PA1443US	8137
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CARR & FERRELL LLP 2200 GENG ROAD PALO ALTO, CA 94303			EXAMINER SELBY, GEVELL V	
			ART UNIT 2615	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/757,179

Applicant(s)

BOYLE ET AL.

Examiner

Gevell Selby

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 February 2001 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 10.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. **Claims 1, 2, 3, 8-12, 15, 16, and 18, 19, and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Loretta et al., US 5,978,016.**

In regard to claim 1, Lourette et al., US 5,978,016, discloses a machine-readable medium (see figure 6, element 128 and column 9, lines 63-65) comprising

an image management program (see column 9, lines 1-18 and 63-65: The microcontroller runs the instruction sets saved in the ROM to control the camera.), the program being executable by an electronic device to perform method steps for capturing, controlling and managing an image (see figure 14 and column 12, lines 13-45), the method steps comprising:

receiving an image from an image capture device coupled to the electronic device (see column 8, lines 60-64 and column 21, lines 10-15);

managing the display of the image on a display screen constituent to the electronic device (see column 21, lines 10-23); and

managing the display of a graphical user interface on the display screen (see column 21, lines 1-9), the user interface comprising at least one interactive icon (see figure 20, elements 24-32),

interactive icon being capable of executing a routine within the program upon activation of said icon by a user (see column 21, lines 6-9).

In regard to claim 2, Lourette et al., US 5,978,016, discloses the machine-readable medium of claim 1, further comprising the step of controlling one or more operational modes of the image capture device (see figure 20, element 23 and column 6, lines 7-8).

In regard to claim 3, Lourette et al., US 5,978,016, discloses the machine-readable medium of claim 1, further comprising the step of transmitting said image from said electronic device to a remote device (see column 20, line 64 to column 20, line 1).

In regard to claim 8, Lourette et al., US 5,978,016, discloses a system for capturing and managing images (see figure 19), comprising:

- an electronic device (see figure 19, element 232), further comprising:

- a processor (see column 21, lines 48-52: It is inherent that the computer has a processor to operate the camera remotely and process the images),

- a display (see figure 20), for selectively displaying text and one or more live or stored images (see column 21, lines 1-6), and

- a memory, for storing said images (see column 21, lines 24-26: It is inherent the computer has a memory to store the images downloaded from the camera);

- an image capture device removably attached to said electronic device (see figure 19, element 10); and

an image management engine loaded into said memory and executed by said processor, the image management engine capable of implementing a plurality of functions for capturing, managing and viewing said images (see column 21, lines 24-60).

In regard to claim 9, Lourette et al., US 5,978,016, discloses the system of claim 8, wherein said electronic device further comprises a transmission source for transmitting image data from said electronic device to a remote device (see figure 19; column 20, lines 59-64).

In regard to claims 10, Lourette et al., US 5,978,016, discloses the system of claim 9, wherein said transmission source is wireless (see column 8, lines 64-67).

In regard to claims 11, Lourette et al., US 5,978,016, discloses the system of claim 10, wherein said transmission source is infrared (see column 8, lines 64-67).

In regard to claim 12, Lourette et al., US 5,978,016, discloses the system of claim 8 wherein said image capture device is a digital camera (see column 8, lines 12-47).

In regard to claim 15, Lourette et al., US 5,978,016, as explained above discloses the system of claim 8 wherein said image capture device comprises an internal memory (see figure 6, element 128).

In regard to claim 16, Lourette et al., US 5,978,016, as explained above discloses the system of claim 15 wherein said image management engine is pre-loaded in said internal memory of said image capture device (see column 9, lines 63-64).

In regard to claim 18, Lourette et al., US 5,978,016, discloses the system of claim 8 wherein said image management engine presents one or more graphical user interface

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icons on said display of said electronic device to facilitate capture or management of images (see figure 20 and column 21, lines 1-9).

In regard to claim 19, Lourette et al., US 5,978,016, discloses a method for managing live images on an electronic device, comprising the steps of:

providing a display for viewing said images on said electronic device (see column 21, lines 10-20);

providing a camera for capturing said images (see column 21, lines 20-22);

and providing one or more image control functions that execute by selecting same (see column 21, lines 1-9).

In regard to claim 20, Lourette et al., US 5,978,016, discloses the method of claim 19 further comprising the step of providing a memory to store said image after capturing (see column 21, lines 44-47).

In regard to claim 24, Lourette et al., US 5,978,016, discloses the method of claim 19 further comprising the step of providing a transmission source for transmitting selected image data to a remote device after capturing (see column 20, line 59 to column 21, line 1).

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**4. Claims 4-7, 13, 14, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lourette et al., US 5,978,016, in view of Tanaka et al., US 6,120,379.**

In regard to claims 4 and 17, Lourette et al., US 5,978,016, discloses the machine-readable medium of claims 1 and 16 respectively. The Lourette reference does not disclose that the program is transferred from the image capture device to the electronic device for execution.

Tanaka et al., US 6,120,379, discloses a electronic device (see figure 1, element 20) coupled to an image capture device (see figure 1, element 30 and column 6, lines 26-35). The image capture device cartridge contains a ROM (figure 13, element 45) which stores a synthesizing program for displaying an image obtained by an image obtained by synthesizing the image data written in the image RAM (57) (see column 10, lines 43-47). When the electronic device (figure 1, element 20) is turned on, the program is transferred from the ROM (figure 13, element 45) of the image capture device (figure 1, element 30) to the CPU (figure 13, element 51) of the electronic device (see column 10, lines 57-59).

It would have been obvious to one skilled in the art at the time of invention to have been motivated to modify Lourette et al., US 5,978,016, in view of Tanaka et al., US 6,120,379, to have the image capture device transfer the program to the electronic device when the image capture device is connected to the electronic device and the power is turned on so that the electronic device does not have to store the program in its ROM and the image capture device can be connected to different electronic device without needing to preload the program in the electronic device.

In regard to claim 7, Lourette et al., US 5,978,016, discloses the machine-readable medium of claim 1. The Lourette reference does not disclose that the electronic device is a handheld device.

Tanaka et al., US 6,120,379, discloses a handheld electronic device (see figure 1, element 20 and column 2, lines 5-8) coupled to an image capture device (see figure 1, element 30 and line 6, lines 26-35). The electronic device and image capture device are portable and allow images to be captured to expand the range of use for entertainment and expand the entertainment value (see column 1, lines 55-59).

It would have been obvious to one skilled in the art at the time of invention to have been motivated to modify Lourette et al., US 5,978,016, in view of Tanaka et al., US 6,120,379, to have the electronic device be handheld to make the system portable in order to expand the range of use and value of the camera as taught by Tanaka.

In regard to claims 5 - 6 and 13 - 14, Lourette et al., US 5,978,016, discloses the system of claims 1 and 8 respectively, wherein said image management engine is stored in the computer's memory (see column 21, line 48-57). The Lourette reference discloses that that the read only memory (ROM 128) stores the instructions or program (see column 9, lines 63-65.) Official Notice is taken that read only memory of the Lourette reference is a magnetic or optical medium, in order to be non-volatile storage to save the program when the camera is turned off. Lourette et al., US 5,978,016, the image management engine is transferred to the electronic device from a magnetic medium or optical medium.



Tanaka et al., US 6,120,379, discloses a electronic device (see figure 1, element 20) coupled to and image capture device (see figure 1, element 30 and column 6, lines 26-35). The image capture device cartridge contains a ROM (figure 13, element 45) which stores a synthesizing program for displaying an image obtained by an image obtained by synthesizing the image data written in the image RAM (57) (see column 10, lines 43-47). When the electronic device (figure 1, element 20) is turned on, the program is transferred from the ROM (figure 13, element 45) of the image capture device (figure 1, element 30) to the CPU (figure 13, element 51) of the electronic device (see column 10, lines 57-59).

It would have been obvious to a person skilled in the art, at the time of invention, to have been motivated to modify Lourette et al., US 5,978,016, in view of Tanaka et al., US 6,120,379, to have the image management engine is loaded into said memory from a magnetic medium or optical medium so that the working memory can be free to perform other programs when it's the managing the camera.

**5. Claims 21 - 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lourette et al., US 5,978,016, as applied to claim 10 and in view of Wakabayashi et al., US 5,097,285.**

In regard to claims 21, 22, and 23, Lourette et al., US 5,978,016, discloses the method of claim 19 and also discloses a timer mode switch (see figure 3, element 30) and timers (see column 9, lines 5-6). The Lourette reference does not disclose that the image is captured by said camera by programming an automatic timer to capture said image within a user-specified time and to capture a user-specified number of images at a user-specified time interval.

Wakabayashi et al., US 5,097,285, discloses a camera with a self-timer (see column 1, lines 26-28). In self-timer mode the user can specify the number of pictures to be taken when the timer expires by pressing the timer button that number of times (see column 3, lines 1-7). The user can specify whether they want the time of the second and following pictures to be longer than the time of the first picture (see column 3, lines 7-13).

It would have been obvious to a person skilled in the art, at the time of invention, to have been motivated to modify Lourette et al., US 5,978,016, in view of Wakabayashi et al., US 5,097,285, to have a self timer mode wherein the image is captured by said camera by programming an automatic timer to capture said image within a user-specified time and to capture a user-specified number of images at a user-specified time interval in order to have time to move from the camera to the position to be photographed as taught by Wakabayashi (see column 3, lines 10-12).

### ***Response to Arguments***

6. Applicant's arguments with respect to claims 1-3 and 5-24 have been considered but are moot in view of the new ground(s) of rejection.

7. Applicant's arguments in regard to claim have been fully considered but they are not persuasive. The applicant's submit the ROM (45) is not a component of the image capture device (30) on page 11 of the amendment. The examiner respectfully disagrees.

Re claim 4) The image capture device includes the cartridge portion which the camera portion is connected to and is needed to perform image capture. The image capture device cartridge

portion contains a ROM (figure 13, element 45) which stores a synthesizing program for displaying an image obtained by an image obtained by synthesizing the image data written in the image RAM (57) (see column 10, lines 43-47).

### *Conclusion*

1. Applicant's submission of an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) on June 28, 2004 prompted the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 609(B)(2)(i). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gevell Selby whose telephone number is 703-305-8623. The examiner can normally be reached on 8:00 A.M. - 5:30 PM (every other Friday off).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Christensen can be reached on 703-308-9644. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

gvs



TUAN HO  
PRIMARY EXAMINER